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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/929,032

08/15/2001

Charles R. Barker JR.

41743

1879

8968

7590

09/20/2005

GARDNER CARTON & DOUGLAS LLP  
ATTN: PATENT DOCKET DEPT.  
191 N. WACKER DRIVE, SUITE 3700  
CHICAGO, IL 60606

EXAMINER

PHAM, BRENDA H

ART UNIT

PAPER NUMBER

2664

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/929,032

Examiner

Brenda Pham

Applicant(s)

BARKER ET AL.

Art Unit

2664

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8,10,11,15-18,21-23,25-27,30-33,36-38,40-42,45 and 46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-2,5-8,10-11,15-18,21-23,25-27,30-33,36-38,40-42,45 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-2, 5-8, 10-11, 15-18, 21-23, 25-27, 30-33, 36-38, 40-42, 45-46 are currently pending in this application.

### ***Double Patenting***

2. Claims 1-46 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-33 of copending Application No. 09/929,031. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: the instant application and copending application claimed a communication network, adapted for use with mobile wireless user terminals. The system and method of the present invention comprises the same subject matters as in the copending Application No. 09/929,031.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Art Unit: 2664

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 5-8, 10-11, 15-18, 21-23, 25-27, 30-33, 36-38, 40-42, 45-46 are rejected under 35 U.S.C 102(e) as being anticipated by La Porta et al (US 6,434,134 B1).

Claims 1, 3, 9, 11, 14, 15, 17, 19, 22, 24, 26, 28, 30, 32, 34, 37, 39, 41, 43 and 45, La Porta et al discloses a method, a communication network, adapted for use with mobile wireless user terminal, said network comprising (see figure 17): a packet-switched core network (internet 360); and a plurality of access points (BS9 thru BS 12) coupled to said core network (360), each said access point being adapted to provide any said user terminal (MD 114) with communications access to said core network (360) when said any user terminal becomes affiliated with said access point, and including an address resolution protocol cache which is adapted to store information representative of affiliation between

Art Unit: 2664

said user terminals and said access points, and each said access point being adapted to update its address resolution protocol cache with an Internet protocol address of a said user terminal when that said user terminal becomes affiliated with said access point, and being further adapted to issue an address resolution protocol request which causes other said access points to update their respective address resolution protocol cache to indicate that a user terminal has changed its affiliation to said access point (column 18, lines 19-26, column 27, lines 45-67, column 28, lines 1-67, column 29, lines 1-67, column 30, lines 1-67, figure 9 and 17).

Claims 2, 12, 18, 27, 33 and 42, La Porta et al further teach wherein said each access point is adapted to issue said message over said core network as an address resolution request for an address of said user terminal which has changed its affiliation thereto (column 27, lines 64-67, column 28, lines 1-22).

Claims 5-6, 10, 16, 21, 25, 31, 40 and 46, La Porta et al teach wherein said access point with which a said user terminal is affiliated is adapted to transmit a received data packet to said user terminal via a wireless communications link (MD communicate with base station, see figure 17).

Claims 8, 23, 38, La Porta et al teach an IP gateway router including a respective an address resolution cache which is adapted to store information

Art Unit: 2664

representative of affiliation between said user terminal and said access points and is updateable based on said message (column 18, lines 19-26 and 51-67).

Claims 4, 13, 20, 29, 35, 44, La Porta et al teach wherein said address of said user terminal includes an Internet protocol address assigned to said user terminal (column 16, lines 25-41, figure 11).

Claim 7, La Porta et al teach wherein all of said access points are within the same broadcast network (see figure 2).

#### ***Conclusion***

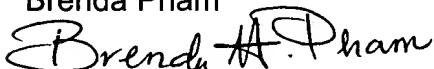
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Pham whose telephone number is (571) 272-3135. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (571) 272-3134.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

September 16, 2005

Brenda Pham

A handwritten signature in black ink that reads "Brenda A. Pham". The signature is written in a cursive style with a large, stylized "B" and "P".